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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,429	08/14/2001	Ronald D. Blum	10551/193	8335
23838	7590	12/02/2003		
KENYON & KENYON 1500 K STREET, N.W., SUITE 700 WASHINGTON, DC 20005			EXAMINER CHIN, RANDALL E	
			ART UNIT	PAPER NUMBER
			1744	

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/928,429		<b>Applicant(s)</b> BLUM ET AL.	
	<b>Examiner</b> Randall Chin		<b>Art Unit</b> 1744	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☐ Responsive to communication(s) filed on \_\_\_\_.

2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-38 is/are pending in the application.

4a) Of the above claim(s) 5, 18-20, 22-33 and 38 is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1, 2, 4, 6-17, 21 and 34-37 is/are rejected.

7) ☒ Claim(s) 3 is/are objected to.

8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
       Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
       Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
       1. ☐ Certified copies of the priority documents have been received.  
       2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
     a) ☐ The translation of the foreign language provisional application has been received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____
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**DETAILED ACTION**

***Election/Restrictions***

1. Claims 5, 18-20, 22-33 and 38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the paper filed October 24, 2003.

Applicant's election of Figs. 24A-24F, claims 1-4, 6-17, 21 and 34-37 in the paper filed October 24, 2003 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. With respect to claims 9-17, independent claim 9 never positively recites the "non-tacky insert" or the "tacky insert", however, dependent claims 10, 11, 12, 13, 14 and 16 appear to positively claim these features. Clarification is respectfully requested here.

Claim 21, line 6, "a area" should read --an area--.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 4, 6, 8-12, 14, 15 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by EPA 0 353 139 (hereinafter EPA '139).

EPA '139 teaches a floor mat assembly comprising a floor mat frame 12, a non-tacky insert defined by tab 28 configured to be received "within" the confines of the frame in plan view, and a tacky insert 16, 26 configured to also be received "within" the confines of the frame in plan view.

As for claim 4, the frame includes a backing material 42 for backing the non-tacky insert.

As for claim 6, the frame includes an area 42 comprising anti-slip components (rubber as set forth in col. 5, lines 21-27).

As for claim 8, the tacky portion is a plurality of tacky sheets 16.

As for claim 9, this claim never positively recites the "non-tacky insert" or the "tacky insert". Clearly, EPA '139 teaches a floor mat assembly comprising a plurality of components that can be assembled.

As for claim 10, there is a non-tacky insert defined by tab 28 configured to be received within the plurality of components.

As for claim 11, there is a tacky insert 16, 26 configured to be received within the plurality of components.

As for claim 12, the plurality of components comprises "perimeter sections" (no requirement that they be separate pieces) defined by base 12 shown in plan view in Fig. 1 forming a perimeter of assembled components and receiving the non-tacky insert.

As for claim 14, the plurality of components comprises a backing section 42 for backing the non-tacky insert.

As for claim 15, the backing section is anti-slip.

As for claim 36, the floor mat assembly comprises a non-tacky portion defined by non-tacky tab 28 and a separate receiving portion defined by base 12 "attachable" to the non-tacky portion, the receiving portion 12 being configured to receive a tacky insert 16, 26.

5. Claims 1, 2, 4, 8-12, 14, 17, 21 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Nappi '393.

Nappi '393 teaches a floor mat assembly comprising a floor mat frame 12, a non-tacky insert defined by tab 28 configured to be received within the frame, and a tacky insert 26 configured to also be received within the frame.

As for claim 2, the frame comprises a perimeter (defined by moldings 14) forming a channel or recess for receiving the non-tacky insert 28.

As for claim 4, the frame includes a backing material 24 for backing the non-tacky insert.

As for claim 8, the tacky portion is a plurality of tacky sheets.

As for claim 9, this claim never positively recites the "non-tacky insert" or the "tacky insert". Clearly, Nappi '393 teaches a floor mat assembly comprising a plurality of components that can be assembled.

As for claim 10, there is a non-tacky insert defined by tab 28 configured to be received within the plurality of components.

As for claim 11, there is a tacky insert 16 configured to be received within the plurality of components.

As for claim 12, the plurality of components comprises "perimeter sections" (no requirement that they be separate pieces) defined by base 12 forming a perimeter of assembled components and receiving the non-tacky insert.

As for claim 14, the plurality of components comprises a backing section 24 for backing the non-tacky insert.

As for claim 17, the components comprises "corner" sections 20, 14 that close the corners of the perimeter.

As for claim 21, there is a floor mat assembly comprising a plurality of perimeter sections 14, 14 (two longitudinal edges in Fig. 1), a backing section 24, "corner" sections 14, 20 (at the ends in Fig. 1) since they still close the corner of the perimeter, a non-tacky insert defined by tab 28, and a tacky insert 26 received on an area of the backing section.

As for claim 36, the floor mat assembly comprises a non-tacky portion defined by non-tacky tab 28 and a separate receiving portion defined by base 12 "attachable" to the non-tacky portion, the receiving portion 12 being configured to receive a tacky insert 26.

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6. Claims 34 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Volz '637.

Volz '637 teaches a floor mat assembly comprising separate components which may be assembled by a user, the separate components comprising a carpet section 22 and a tacky (adhesive) section (see col. 4, lines 37-40 and Abstract). As for claim 37, the non-tacky portion 22 is a carpet.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 34 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by McKay '442.

McKay '442 teaches a floor mat assembly (Figs. 3 and 4) comprising separate components which may be assembled by a user, the separate components comprising a tacky section and fibers or threads (carpet) [see col.4, line 46 to col. 5, line 20]. As for claim 35, the tacky section comprises sheets (Fig. 4).

8. Claims 1, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood '265.

Wood '265 teaches an assembly comprising a frame 22, a non-tacky insert defined by layer 12 configured to be received within the frame, and a tacky insert 16 configured to also be received within the frame. As for the assembly being a floor mat, a

recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

As for claim 6, the frame includes an area defined by stems 14 (Fig. 1) comprising anti-slip components.

As for claim 7, the tacky insert 16 has apertures for receiving the anti-slip components 14 (Fig. 1).

9. Claims 9-11 and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Calhoun '246.

As for claim 9, this claim never positively recites the "non-tacky insert" or the "tacky insert". Calhoun teaches an assembly comprising a "plurality of components" that can be assembled. As for the assembly being a floor mat, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result



in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

As for claim 10, there is a non-tacky insert defined by projections 18 configured to be received within the plurality of components.

As for claim 11, there is a tacky insert 16 configured to be received within the plurality of components.

As for claim 14, the plurality of components comprises a backing section 22 for backing the non-tacky insert 18 (Fig. 1).

As for claim 15, the backing section can be considered "anti-slip."

As for claim 16, the tacky insert has apertures for receiving the anti-slip components 18.

10. Claims 9, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Japan '891.

As for claim 9, this claim never positively recites the "non-tacky insert" or the "tacky insert". Clearly, Japan '891 teaches a floor mat assembly comprising a plurality of components that can be assembled.

As for claim 12, the plurality of components comprises "perimeter sections" (no requirement that they be separate pieces) defined by base 12. Any of the drive components can be considered "non-tacky". The figures show an end portion of the tacky insert received within a recess defined by housing 20C.

***Allowable Subject Matter***

11. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randall Chin whose telephone number is (703) 308-1613. The examiner can normally be reached on Monday through Thursday and every other Friday. **A scheduled move is set for December 16-17, 2003 and the Examiner can then be reached at new telephone number (571) 272-1270.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Warden can be reached on (703) 308-2920. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



R. Chin



Randall Chin  
Primary Examiner  
Art Unit 1744